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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,187	03/10/2004	Norbert Rick	MERCK-2862	2740

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/796,187

Applicant(s)

RICK ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The specification is objected to as failing to provide proper *antecedent basis* for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The limitation “phosphate” as defined in claim 1, layer (D) is not defined in the specification.

The limitations “CVD” or “PVD” process, as defined in claims 16 are not defined in the specification.

Claims 1-7 and 9-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schoen et al. US 2002/0192448 for the same reasons set forth in the previous office action which are incorporated herein by reference.

New claim 21 is rejected under 35 U.S.C. 103(a) as obvious Schoen et al. US 2002/0192448.

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Although this reference does not literally the combination of substrate materials, it is prima facie obvious to combine two or more materials (substrate) disclosed by the prior art to form a third material (combination of substrate materials) that is to be used for the same purpose. In re Kerkhoven 205 USPQ 1069.

Claims 1-7 and 9-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,884,289 for the same reasons defined in the previous provisional ODP rejection (provision ODP rejection was based on this reference as a application) which are incorporated herein by reference. Between the time of the previous office action and the instant office action, copending 10/128,521 (basis for previous provisional ODP rejection) has matured into the above patent, thus the art relied upon is not new.

New claim 21 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,884,289.

Although this reference does not literally claim a combination of substrate materials, it is prima facie obvious to combine two or more materials (substrate) disclosed by the prior art to form a third material (combination of substrate materials) that is to be used for the same purpose. In re Kerkhoven 205 USPQ 1069.

Applicant's arguments filed 6/13/06 have been fully considered but they are not persuasive.

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Applicants argue the objection to the specification in that the meaning of these terms is known. The examiner realizes this, but the objection was based on the lack of antecedent basis for the claimed subject matter of “phosphate”, “CVD” and “PVD” and not the meaning of the terms. To correct this, applicants are required to include the above subject matter into the specification.

With respect to the art rejections, applicants argue that Schoen et al. does not teach a specific embodiment which corresponds to the claimed absorbent layer “D” and only specifically defines that this layer (absorbent layer) is Prussian blue and none of the examples disclose this layer. Applicants arguments are based on the preferred embodiments of the reference, and as is well established, as reference is not limited to its preferred teachings but rather all that it realistically teaches. The reference clearly teaches in column 3, lines 19-28 absorbent layer materials which clearly fall within the scope of the instant claims. Applicants appear to argue that the reference teaches a generic disclosure of the absorbent layer. The examiner disagrees because the reference clearly teaches that the absorbent layer is a metal oxide, metal sulfide, metal selenide, etc. Such a disclosure is not a generic disclosure because the claimed materials are literally defined. Applicants appear to support the argument by citing In re Kollman et al. This citation, however, is directed to a showing of unexpected results for a range and thus is not pertinent to the previous rejection.

Applicants continue to argue that, although the reference defines the covering (D) of absorbent particles as a layer, this is clearly different from the layer of the claimed invention. The examiner is unclear as to applicant argument because a claim can be given its broadest interpretation and the applicants do not distinguish the absorbent layer (D) of the instant claims

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with the absorbent layer of the reference (i.e. reference layer (D) is a layer of absorbent particles, thus broadly reading on the claimed absorbent layer). Applicants also state that it is clear from the specification that the claimed layer is homogeneous layer. Notwithstanding this argument, this is not claimed. Assuming *arguendo*, the examiner is unable to find support for applicants position. Applicants state that the layer of the instant claims is made by wet chemical methods. Although this may be true, so is the absorbent layer of the reference. Applicants state that although the reference teaches that the *layer* is applied by wet chemical methods, it does not disclose that the layer of absorbent particles is applied by wet chemical methods. First applicants are arguing process limitations which are irrelevant to the product claims absent unexpected results and second, if the oxide layer (i.e. this is an absorbent layer since metal oxides are used) of the reference is applied in this manner and oxides are particles, the metal oxide particle layer (absorbent layer) is applied in a manner consistent with wet chemical methods. Finally applicants argue that the layer of the reference will give differing reflection properties when compared to the claimed layer. Applicants provide no evidence to support this. Since the layer, as broadly interpreted, can be the same, one would expect the properties thereof to also be the same. In addition, applicants do not claim any properties that might provide a distinction.

Applicants have not show clear evidence (comparison between the reference and the instant claims) that distinguished the reference product from the claimed product

Applicant's amendment necessitated the new ground(s) of rejection (for new claim) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

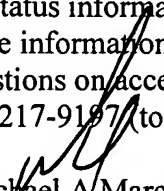
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/06  
MM

  
Michael A Marcheschi  
Primary Examiner  
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